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Atty. Dkt. No. 053466-0372

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tetsuya KANEMARU et al.
Title: SILICONE-TREATED POWDER, PROCESS
OF PRODUCTION THEREOF AND
COMPOSITION CONTAINING THE SAME
Appl. No.: 10/679,298
Filing Date: 10/7/2003
Patent No.: 7,449,193
Grant Date: 11/11/2008
Examiner: Bethany P. BARHAM
Art Unit: 1615
Conf. No.: 3585

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 11/11/2008 as U.S. Patent No. 7,449,193.

The Patent Office determined that the patent was entitled to 365 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-

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year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 158 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	459 days
(b) Total Applicant delay:	301 days
Final PTA Determination:	158 days

Applicants therefore respectfully request that the patent be accorded 158 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date JAN 05 2009

By 

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 053466-0372
 Application Number: 10/679298
 Patent Number: 7449193

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	10/07/2003	0		
	14 month From Application date	12/07/2004	427		
Edit Delete	Restriction Requirement	03/11/2005	521	94	
Edit Delete	Restriction Requirement Response Received at PTO	04/08/2005	549		
Edit Delete	Non-Final Office Action	04/27/2005	568		
	Non-Final Office Action + 3 months	07/27/2005	659		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	10/27/2005	751		92
Edit Delete	Final Office Action	02/02/2006	849		
	Final Office Action + 3 months	05/02/2006	938		
Edit Delete	Notice of Appeal Received at PTO	07/03/2006	1,000		62
Edit Delete	Final Office Action Response Received at PTO	07/03/2006	1,000		
Edit Delete	Non-Final Office Action	09/11/2006	1,070		
	3 Year Period Starts	10/07/2006	1,096		
	Non-Final Office Action + 3 months	12/11/2006	1,161		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	03/09/2007	1,249		88
Edit Delete	Final Office Action	05/29/2007	1,330		
	Final Office Action + 3 months	08/29/2007	1,422		
Edit Delete	Request For Continued Examination	09/28/2007	1,452		30
	3 Year Period Stopped	09/28/2007	1,452	356	
Edit Delete	Non-Final Office Action	10/31/2007	1,485		
	Non-Final Office Action + 3 months	01/31/2008	1,577		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	02/29/2008	1,606		29
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	06/29/2008	1,727		
Edit Delete	Notice of Allowance	07/08/2008	1,736	9	
Edit Delete	Issue Fee Paid	10/07/2008	1,827		
Edit Delete	Patent Grant Date	11/11/2008	1,862		

Totals:	459	301
PTA:	158	



Version: 3.02.04

LOGIN: Karen Walker

IP: 10.14.42.130

Foley & Lardner LLP